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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/496,467 02/02/00 BODKIN

L D-7211(1156)

EXAMINER

PM82/0425

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112 West Adams Street
Ste 1305
Jacksonville FL 32202

HAWKINS, J

ART UNIT

PAPER NUMBER

3672

DATE MAILED:

04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/496,467

Applicant(s)

BODKIN, LAWRENCE E

Examiner

Jennifer M Hawkins

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 16 and 17 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the first sentence of the abstract is merely a recitation of a phenomenon and is considered improper. The first sentence should be deleted from the abstract. Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The disclosure is objected to because of the following informalities:

Art Unit: 3672

- A. On page 2 the two phrases that are centered on the page should be left justified and the respective paragraphs rearranged accordingly. Further, the two centered phrases appear to be sentence fragments and should either be deleted or worked into the respective paragraphs.
 - B. On page 3, line 6, "You" should be changed to --you--.
 - C. On page 11, line 5, --view-- should be added after "cross-sectional".
- Appropriate correction is required.

Claim Objections

4. Claims 9, 10, 16, and 17 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The above claims merely site that the cavity is made with walls that conform to the shape of the floating object. This limitation is recited in lines 3 and 4 of claim 1 and lines 5-7 of claim 15

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- A. Claim 1, line 3, recites "an object". The claim is considered vague and confusing because it is unclear if applicant is referring to the object mentioned in line 1 of the claim or a new and separate object. It is suggested that line 3 be changed to read --the object--.
 - B. Claim 1, line 4, recites "such conformal walls". The claim is considered vague and confusing because it is unclear if applicant is referring to the walls

mentioned in line 2 of the claim or new and separate walls. It is suggested that line 4 be changed to read --the conformal walls--.

- C. Claim 1, line 5, recites "a contained liquid". The claim is considered vague and confusing because it is unclear if applicant is referring to the liquid mentioned in line 2 of the claim or a new and separate liquid. It is suggested that line 5 be changed to read --the contained liquid--.
- D. Claim 1, line 7, recites "a volume of the liquid". A liquid inherently has a volume thus it is not necessary to positively recite "a volume". It is suggested that line 7 be changed to --the volume of the liquid--.
- E. Claim 5, line 3, recites "an object". The claim is considered vague and confusing because it is unclear if applicant is referring to the object mentioned in line 1 of the claim or a new and separate object. It is suggested that line 3 be changed to read --the object--.
- F. Claim 5, line 5, recites "such conformal walls". The claim is considered vague and confusing because it is unclear if applicant is referring to the walls mentioned in line 2 of the claim or new and separate walls. It is suggested that line 5 be changed to read --the conformal walls--.
- G. Claim 5, line 6, recites "a contained liquid". The claim is considered vague and confusing because it is unclear if applicant is referring to the liquid mentioned in line 2 of the claim or a new and separate liquid. It is suggested that line 6 be changed to read --the contained liquid--.
- H. Claim 5, line 8, recites "a weight of the liquid". A liquid inherently has a weight thus it is not necessary to positively recite "a weight". It is suggested that line 8 be changed to --the weight of the liquid--.
- I. Claim 9, line 1, recites "to have walls". The claim is considered vague and confusing because it is unclear if applicant is referring to the walls mentioned in line 2 of claim 1 or new and separate walls. It is suggested that line 1 be changed to read --so the walls--.
- J. Claims 9 and 10, line 2, recite "a preexisting object". The claim is considered vague and confusing because it is unclear if applicant is referring to the object

mentioned in line 1 of claim 1 or a new and separate object. It is suggested that line 1 be changed to read --the preexisting object--.

- K. Claim 15, line 4, recites "an immersible object". The claim is considered vague and confusing because it is unclear if applicant is referring to the object mentioned in line 3 of the claim or a new and separate object. It is suggested that line 4 be changed to read --the immersible object--.
- L. Claim 15, line 4, recites "a liquid". The claim is considered vague and confusing because it is unclear if applicant is referring to the liquid mentioned in line 2 of the claim or a new and separate liquid. It is suggested that line 6 be changed to read --the liquid--.
- M. Claim 16, line 1, recites "a preexisting object". The claim is considered vague and confusing because it is unclear if applicant is referring to the object mentioned in line 3 of claim 15 or a new and separate object. It is suggested that line 1 be changed to read --the preexisting object--.
- N. Claims 11-14, 18, and 19 provides for the use of the device and improvement, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 11-14, 18, and 19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 2-4, 6-8, and 17 are also considered indefinite because the claims from which they depend, claims 1, 5, and 15, are considered indefinite.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. All of the above claims are directed toward the Applicant's revised buoyancy law. Laws of nature, such as Archimedes' Principle (see Elementary Fluid Mechanics, pages 64 and 65 and *Archimedes' Principle*), are not considered statutory subject matter thus are not patentable. Further, any new discoveries, such as a new law of nature, are considered "manifestations of...nature, free to all men and reserved exclusively to none." (See MPEP 2105) However, the Applicant's revised law is considered a violation of the established natural law of buoyancy and such violations of laws of nature have been upheld by the Federal Courts as not patentable.

Rejections under 35 U.S.C. 101 have been rarely sustained by Federal courts. Generally speaking, in these rare cases, the 35 U.S.C. 101 rejection was sustained either because the applicant failed to disclose any utility for the invention or asserted a utility that could only be true if it violated a scientific principle, such as the second law of thermodynamics, or a law of nature, or was wholly inconsistent with contemporary knowledge in the art. In re Gazave, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967). (MPEP 2107.01)

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Archimedes' Principle and Elementary Fluid Mechanics disclose the basic principles behind Archimedes' Principle.

SU 996672 A discloses a support column that uses fluid pressure and buoyancy in an inner cavity to support an inner pipe.

Seely discloses a common canal lock.

Rodney discloses a canal lock with various wall shapes.

Dutton discloses an aqueduct that is shaped similar to the bottom of a ship thus would conform to the shape of the ship if the same concept were used in a canal lock.

Buzzell discloses an canal lock that contains an apparatus to change to overall shape of the lock. This allows the lock to conform to the shape of a passing boat or ship.

Omachi discloses a lock that uses air chambers to control the water level in the lock as well as shape of the lock.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer M Hawkins whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Friday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-7687 for regular communications and (703) 306-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

JMH *JMH*
April 16, 2001

William Neuder
William Neuder
Primary Examiner